



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

8/16/03
11-37

Alexander Stenzel

Serial No.: 10/036,341

Filed: 12/26/01

For: VEHICLE MIRROR MOUNTING
APPARATUS AND METHOD FOR
ASSEMBLING SAME

Examiner: Sikder, Mohammad Yunus

Group Art Unit: 2872

Docket No.: LMX-88

Mail Stop Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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RESPONSE TO THE PTO ACTION OF 9-24-2003

Claims 1-20 are presented.

Restriction has been made classifying claims 1-3, 5-12 and 18-19 as Group I;
claims 13-15 as Group II; claims 16-17 as Group III; and, claim 18 as Group IV.

- I. Claims 1-3, 5-12, 18-19 are said to be drawn to a mirror mounting apparatus properly classified in class 359, subclass 841.
- II. Claims 13-15 are said to be drawn to specific features of the mirror housing called for in Group I and are properly classified in class 359, subclass 871.
- III. Claims 16-17 are said to be drawn to a specific way to compress the compression element called for in Group I and are properly classified in class 359, subclass 877.

IV. Claim 20 is said to be drawn to a method of assembling the rear view mirror mounting of Group I and is properly classified in class 359, subclass 900.

The inventions I and II, along with I and III are said to be combination and sub-combination which are distinct if it can be shown that: 1) the combination as claimed does not require the particulars of the sub-combination for patentability; and, 2) that the sub-combination has utility by itself or in other combinations.

The inventions II and III are said to be sub-combinations usable together. Sub-combinations are distinct from each other and properly restricted if shown to be separately usable.

Inventions I and IV, II and IV, and III and IV are said to be related as process of making and product made. These inventions are distinct if either: 1) the process as claimed can be used to make other and materially different product; or, 2) the product as claimed can be made by another process.

It is asserted that the product as claimed can be made by a different process.

The Examiner asserts that the combination of Group I does not require the particulars of the sub-combinations II or III and that each sub-combination has independent utility.

This restriction requirement is respectfully traversed as improper.

With respect to Group I, the claims are directed to mirror mounting apparatus 10. The claims of Group I then proceed to claim the elements which comprise that apparatus to include mirror housing, mounting bar with a cavity and aperture, a base member, first, second and third openings, a cap member, first and second side

members, spherical surfaces, receiving surfaces, compression springs, fastener members, keys, projections, notch configurations, a plurality of base surfaces, etc., all defined in varying degrees of specificity.

The claims of Groups II and III also recite these same combinations of elements forming a mirror mounting assembly in varying degrees of specificity. The claims of Groups II and III are combination claims in the sense that the claims of Group I are combination claims and are properly grouped with the claims of Group I. The claims of Groups II and III are not sub-combination claims as the same elements are claimed in the claims of Groups I, II and III.

Insofar as Group IV, to the method of forming the mirror mounting assembly of groups I, II, and III, the Examiner fails to comply with MPEP 806.05(g) which requires a description of the materially different process. No such process is referred to. The requirement for restriction is therefore improper.

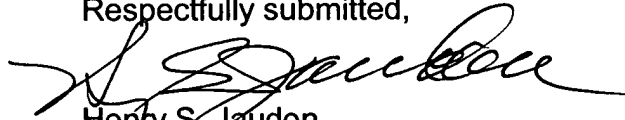
MPEP 803.01 states "If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on its merits, even though it includes claims to independent inventions".

It is noted that the classification for the claims of groups I, II, III and IV as set forth in the restriction requirement is class 359. This being the case, it is not seen that "serious burden" is brought about and therefore, it would appear proper that the Examiner examine all claims on their merits.

Accordingly, it is respectfully requested that the Examiner withdraw the restriction requirement and render an action on the merits of all claims presented.

In order to comply with the requirement of 37 CFR 1.143, the claims of Group I,
i.e. claims 1-3, 4, 5-12, 18-19 are elected, the election being made with traverse.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "H. S. Jaudon", written over the typed name.

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TRANSMITTAL LETTER

Please find the following correspondence items enclosed for filing in the United States Patent and Trademark Office:

1. Response to the PTO Action of 9-24-2003;
2. Revocation and Reappointment of Power of Attorney; and
3. Return Receipt Postcard.

Respectfully submitted,

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By:

Date: 10-21-2003